

REMARKS

This is a submission pursuant to 37 C.F.R. 1.114 to the Office Action mailed October 18, 2005 (referred to herein as the Office Action). All pending claims in the present application have been finally rejected in the Office Action. The specifics of the rejections are discussed in further detail below. The Examiner's review and reconsideration of this application, and in particular of the rejections of the claims in the Office Action, in light of the foregoing amendments and the following remarks is respectfully requested.

Prior to addressing the rejections, we offer a short summary of the present invention to assist with an understanding of how the pending claims distinguish from the cited references. At its core, the present invention is a system for efficiently allowing a server to serve selected file content (e.g., web page content) based on characteristics of a client device receiving the content. Two categories of content are provided by the server: non-optional and optional. All non-optional content is provided to the client device. The optional content is organized hierarchically based upon, for example, the demands placed on the client device to interact with the particular optional content. For example, a client device having a high bandwidth connection to the server may be adequately capable of receiving and displaying a full-color dynamic and navigable image of a map with a route highlighted thereon, while a cellular telephone may adequately be capable of displaying only a static, non-interactive, monochromatic version of such a map. The present invention is a system for sorting the optional content and providing the appropriate content in response to a determination of one or more characteristics of the client device or the channel delivering the content.

Importantly, the present invention does not require multiple versions of a file such as web page, and serve the appropriate version in response to determined client characteristics, as is known in the art. Rather, the present invention extracts from a single file, such as a web page, non-optional and optional content, and organizes the optional content within the file for delivery in response to the determination of client device (or channel) characteristics.

While these broad statements help us understand important aspects of the present invention, it is axiomatic that patentable differences must be based in the language of the claims. Accordingly, following is a discussion of the specific rejections, and how and where the language found in the claims of the present application differ from the teachings of the cited references.

Rejections based on 35 USC §102(e)

Claims 1, 2, 5, 8-16, 20, 21, 24, 27-31-33, and 36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Himmel (U.S. Patent 6,167,441). Initially, it will be noted that claims 10, 14-16 , 29 and 36 have been cancelled herein, and are therefore not further discussed.

As stated above, the present invention is a method and medium capable of serving selected elements of a single file to a client device, the selection of elements based upon the characteristics of the client device or channel employed to deliver the elements. The single file contains both non-optional content and optional content. While the non-optional content is provided to the requesting device regardless of the characteristics of the device or the performance of the channel, the selected elements provided to the client device are chosen

from among the optional content. For example, independent claim 1, as amended, is a method with the steps of:

storing a plurality of files, at least one of said files containing non-optional content data and optional content data;

receiving a request for content data from a client device, the content data contained in said at least one of said files;

transmitting the non-optional content data and the selected optional content data to the client device. (Claim 1, as amended, lines 3-17, emphasis added.)

Claim 20 likewise is a method with the steps of:

storing a plurality of web pages, at least one of said web pages containing non-optional content data and optional content data;

receiving a request for transmission of at least said one of the said web pages from a remote device;

transmitting the at least one web page, including the non-optional content data and the selected portion of optional content data to the remote device. (Claim 20, as amended, lines 2-14, emphasis added.)

And claim 30 is a device configured to:

store a plurality of files, at least one of said files containing non-optional content data and optional content data;

receive a request for content data from a client device, the content data contained in said at least one of said files;

transmit the non-optional content data and the selected optional content data to the client device. (Claims 30, as amended, lines 4-18, emphasis added.)

Himmel contains no disclosure of a single file with separated in portions that may or may not be delivered to a client based on the client or channel characteristics. In fact, contrary to the limitations cited above, Himmel teaches storing multiple different versions of a file for multiple different platforms, and transmitting to a client device the appropriate version of the file as identified based on the client device characteristics. In applicant's prior response, a number of passages of Himmel were identified supporting this interpretation of the reference. For example:

- "The client request is redirected to a Uniform Resource Locator (URL) according to the detected client device capability information to retrieve a version of the requested file." (Abstract, emphasis added.)
- "The client request is redirected to a Uniform Resource Locator (URL) according to the detected client device capability information to retrieve a version of the requested file." (Col. 2, lines 32-35, emphasis added.)
- "The client-smart agent 113 redirects the client request to the appropriate web page depending on the detected client type." (Col. 6, lines 33-35, emphasis added.)
- "The utilities would enter into a dialog with the utility to make a respective page for each supported device." (Col. 9, lines 11-13, emphasis added.)

That the present invention enables the serving of content from a single file means that multiple different versions of a file for multiple different platforms need not be prepared. Time, cost, storage space, etc. are saved both in the creation of files (such as web pages) and in their

update and maintenance (only one file need be updated if, for example, a phone number should change, as compared to an update of each different instance of the file as would be required by the teachings of Himmel). And the present invention relieves the designed from having to anticipate every possible client device and create an appropriate version of a web page for each.

It is pointed out in the Office Action that Himmel discloses “[t]he selected web page is dynamically reformatted, if necessary, according to the detected client type.” (Col. 7, lines 36-39.) However, neither this clause nor any other in Himmel, disclose or suggest a server providing, from a single file, non-optional and selected optional content, the selection of the optional content being based upon the characteristics of the client device or the delivery channel. The entire process disclosed by Himmel hinges upon the preparation of multiple instances of a web page, each instance being appropriate for a different class of client device, and the passage cited above does not contradict this. Furthermore, above-cited clause from the Himmel patent is limited to the format of a web page (col. 7, line 37), as distinguished from the content of a web page (the later being a focus of the present invention).

It is asserted in the Office Action that col. 10, lines 43-46 of Himmel disclose “selecting optional content responsive to the performance characteristics of the requesting client device.” However, the cited portion of claim 8 of Himmel depends from and contains all of the limitations found in the claim from which it depends, namely claim 1. Claim 1 specifically says that a request for content is routed to an appropriate URL “according to the detected client device display capability information to retrieve a version of the requested file.” (Claim 1, lines 11-13., emphasis added.) That is, claim 8 discloses that a request for content must both be directed to a URL depending on the display capability of the client device and then aspects of the contents

at that URL are modified according to the capabilities of the client device. Nowhere does the cited portion of Himmel disclose selecting and delivering only elements of a web page, nor selecting such elements from a grouping of optional content based on client device characteristics and delivering those elements together with non-optional content to the client device, as claimed in claims 1, 20, and 30 of the present application.

It is well established that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. In the present case, the elements in the quoted portions of claims 1, 20, and 30, above (that a single file includes both non-optional and optional content, the non-optional and portions of the optional content being delivered to a client device, the selection of the optional portions based upon the characteristics of the client device or delivery channel) are neither expressly nor inherently found in Himmel. Accordingly, the Himmel reference does not anticipate claims 1, 20, or 30 as amended and presented above. For this reason, applicant asserts that claims 1, 20, and 30 are patentably distinct from Himmel, and accordingly requests reconsideration and allowance thereof.

Claims 2, 5, 8-9, and 11-13 depend from and contain all of the limitations found in claim 1. Since claim 1 has been demonstrated to be patentably distinct from Himmel, claims 2, 5, 8-9, and 11-13 must differ from that reference for at least the same reasons. Likewise, claims 21, 24, 27, and 28 depend from and contain all of the limitations founding claim 20. Since it has been demonstrated above that Himmel does not anticipate claim 20, it logically follows that Himmel cannot anticipate the further limited claims 21, 24, 27, and 28. Finally, claims 31 and 33 depend from and contain all of the limitations found in claim 30. It has been demonstrated above that Himmel does not anticipate claim 30. Thus, that reference cannot anticipate claims

which simply add further limitations to claim 30, as do claims 31 and 33 by their dependence on thereon. Accordingly, applicant asserts that for at least the reason of their dependence upon unanticipated claims, dependent claims 2, 5, 8-9, 11-13, 21, 24, 27, 28, 31, and 33 are not anticipated by Himmel. Therefore, applicant requests reconsideration and allowance of said claims.

Rejections based on 35 USC §103

Claims 3, 4, 6, 7, 22, 23, 25, 26, 32, 34, and 35 were rejected under 35 U.S.C. § 103 as being unpatentable of Himmel (U.S. Patent 6,167,441) in view of Ogdon et al. (U.S. Patent 6,598,075, referred to herein as Ogdon).

Initially, applicant asserts that in this context the combination of Himmel and Ogdon is improper, as these references lack any suggestion or motivation to make such a combination. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention." Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1385 (Fed. Cir. 2001).

Himmel is concerned with a method for selecting an appropriate version of a web page to serve to a client device based on the client device's display characteristics. Ogdon is concerned with a method for simultaneously providing a presentation to multiple viewers, two or more viewers employing different network transmission rates. There is no express or implied proposition in either reference to look to the art of synchronizing on-line presentations for suggestions to extend Himmel to a technique for serving a file without having first prepared

multiple versions of that file. Likewise, there is no express or implied proposition in either reference to visit the art of serving files to different device types for suggestions to extend the teachings of Ogdon to customizing web pages delivered to different types of client devices at their request. A person of ordinary skill in the art must be provided some motivation by the references to combine their teachings in the particular manner claimed. In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In hindsight it may seem appropriate to make the combination of Himmel and Ogdon, and perhaps even that such a combination might anticipate aspects of the present invention. However, it is well established that such hindsight is improper. "When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight learned from the invention itself." Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

Moreover, the burden is on the Examiner in the first instance to explain how the prior art suggests and motivates the proposed modification so as to render obvious the claimed invention. Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990). There is no suggestion in the references identified in the statement that "[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Ogdon with Himmel because Ogdon's teachings would have provided the capability for facilitating the customization of the selected Web pages in an Internet environment based on the capability information of the requesting client devices and for efficiently transmitting the customized Web

pages to the requesting client.” (Office Action, page 7, 4th paragraph.) Such a statement, in the words of the Board of Patent Appeals, “is a conclusion, rather than a reason.” Ex parte Garrett, 1986 Pat. App. LEXIS 8, 4 (EPAI 1986) .

Thus, applicant asserts that the combination of Himmel and Ogdon is improper, and cannot be used as a basis to support a finding of obviousness. Accordingly, applicant asserts that claims 3, 4, 6, 7, 22, 23, 25, 26, 32, 34, and 35 are not rendered obvious by the combination of Himmel and Ogdon, and applicant requests reconsideration and allowance of those claims.

However, even if the combination of Himmel and Ogdon were permissible, applicant argues that the combination fails to render the subject matter of the rejected claims obvious. It has been established above that Himmel lacks a teaching of a single file having optional elements which may be delivered to a client device depending on the characteristics of the client device. Ogdon similarly lacks such a teaching. Ogdon discloses providing two client nodes in a network with content from various web servers. Ogdon states at col. 3, lines 40 – 45, that “it is an aspect of the present invention to dynamically and adaptively switch between content web-servers and/or versions of the presentation according to network transmission characteristics...” (emphasis added). Furthermore, the system disclosed by Ogdon generates signals for “identifying the next collection of corresponding versions of video segments from which a client node is to select...” (col. 4, lines 36-37, emphasis added). What this means is that Ogdon, like Himmel, stores different versions of the presentation, and selects the proper version depending upon the characteristics of the delivery channel.

Applicant respectfully asserts that there is no teaching in Ogdon which fills the gap between the teachings of Himmel and the present invention. Both Himmel and Ogdon fail to teach, suggest or disclose:

storing a plurality of files, at least one of said files containing non-optional content data and optional content data;

receiving a request for content data from a client device, the content data contained in said at least one of said files;

transmitting the non-optional content data and the selected optional content data to the client device. (Claim 1, as amended, lines 3-17, emphasis added.)

Accordingly, the combination of Himmel and Ogdon must also fail to teach, suggest or disclose such limitations.

With regard to claims 3, 4, 6, and 7, these claims depend from and contain all of the limitations found in claim 1, and indeed add further limitations themselves. The combination of Himmel and Ogdon, even if considered proper, fails to teach, suggest or disclose the limitations of claim 1, and thus clearly fails to teach, suggest or disclose all limitations found in claims 3, 4, 6, and 7. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, no prima facie case of obviousness has been made with regard to claim 3, 4, 6, and 7, and their reconsideration and allowance are respectfully requested.

Similarly, claims 22, 23, 25, and 26 depend from and contain all of the limitations found in claim 20, and add further limitations themselves. Claim 20 contains limitations parallel to

those found in claim 1 cited above. Therefore, the combination of Himmel and Ogdon, even if considered proper, fails to teach, suggest or disclose the limitations of claim 20, and thus clearly fails to teach, suggest or disclose all limitations found in claims 22, 23, 25, and 26. Thus, no prima facie case of obviousness has been made with regard to claim 22, 23, 25, and 26, and their reconsideration and allowance are respectfully requested.

Finally, claims 32, 34, and 35 depend from and contain all of the limitations found in claim 30, and add further limitations themselves. Claim 30 contains limitations parallel to those found in claim 1 cited above. Therefore, the combination of Himmel and Ogdon, even if considered proper, fails to teach, suggest or disclose the limitations of claim 30, and thus clearly fails to teach, suggest or disclose all limitations found in claims 32, 34, and 35. Thus, no prima facie case of obviousness has been made with regard to claim 32, 34, and 35, and their reconsideration and allowance are respectfully requested.

New Claims 38 – 40

As a final comment herein, applicant points out that new claims 38 – 40 represent cancelled portions of claims 1, 20, and 30. Applicant offers that new claims 38 – 40 now more particularly point out and distinctly claim the subject matter which applicant regards as its invention.

Conclusion

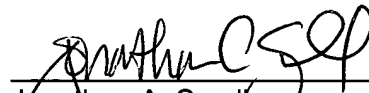
In view of the foregoing, applicant believes all claims pending in this application now distinguish over the cited art and are in condition for allowance. The issuance of a formal Notice of Allowance of this application at the earliest possible date is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,

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